REMARKS

Status of Claims

Claims 1, 88, 91-95, 97-106, 118-120, 130-136, 138-141, 143-158, and 160-164 are pending.

Claims 95, 130-136, 141, 143-144 and 146-158 are withdrawn from consideration by the Examiner as discussed in the Office Action with a notification date of May 14, 2009.

Applicants reserve the right to pursue any canceled subject matter in one or more related applications.

Support for Amendments

Claim 95 is amended to include the phrase "followed by" as suggested by the Examiner. See Office Action, p. 3, paragraph 6. Support can be found in the specification as filed, for example at pages 2-3.

No new matter is introduced by the amendment.

Election/Restriction

Claims 95, 130-136, 141, 143-144 and 146-158 are withdrawn from consideration. In particular, the Office Action indicates that claims 95 and 141 recite both a wet-sampling step and a dry-sampling step, or a step of swiping a pre-wetted surface with a second dry swab, rendering the claims materially different from that which was previously claimed and examined on the merits. The Office Action withdraws the claims as non-elected by original presentation. Applicants request clarification as to the status of claim 145, which is not withdrawn, but depends from withdrawn claim 144.

Applicants respectfully traverse the finding of non-election by original presentation. Claim 95 was filed on June 16, 2006, which was prior to examination, and included both wet-sampling and dry-sampling steps. As such, Applicants request that the finding of non-election by original presentation be vacated.

Interview Summary

Applicants thank the Examiner for the courtesy of a telephone interview with Michael Willis on June 23, 2009. The substance of the interview was a discussion of trademarks and USPTO policy regarding attempts to identify the material in a product based on trademark information. It was agreed that Applicants would submit arguments that trademarks identify the source of a product, but do not identify the product itself, and that the Examiner would consider the arguments fully.

Claim Rejections

35 U.S.C. §102(b) and 103(a)

The Office Action rejects claims 91-94, 97-99, 101, 103, 105, 106, 118-120, 138-140, 161, 163, and 164 under 35 U.S.C. §102(b) as being anticipated by Kelly (Brit. J. Surgery, 65:2, Abstract only) and claims 1, 88, 100, 102, 104, 160, and 162 as being unpatentable in view of Kelly combined with D'Alessio (US Patent No. 6,283,933), Lea (US Patent Publication No. 2002/0019062), Laskey (US Patent No. 6,303,323), or Ranjane (JP 09-296004, English Abstract only). For each rejection, the Office Action relies on Kelly as disclosing a Gelfoam® swab "which is by its nature a gelatin-based sponge," (Office Action, p. 4, line 20). For the convenience of the Examiner, Applicant's submit with this paper a copy of the full Kelly reference rather than the Abstract relied upon by the Office Action.

Applicants respectfully traverse on the basis that Kelly fails to disclose or suggest a swab wherein said swab is a gelatin-based sponge as required by all of the claims. As described in the full reference, Kelly teaches the use of either a "standard cottonwool variety" swab or a "polyester foam swab" for the purpose of comparing the efficacy of each type of swab. See Kelly, p. 81, left column, lines 10-12. In the "Materials and Methods" section of the reference, Kelly specifically teaches

> [t]wo different types of culture swab were used: a home-made wooden-handled cottonwool swab in a glass tube and wooden-handled Gelfoam swabs* made from polyester foam.

(Kelly, p. 82, left column, lines 23-25). In the footnote according to the asterisk, Kelly indicates

that the Gelfoam swabs are supplied by Messrs. McDonald & Company.

As evidence that the Gelfoam® swabs according to Kelly are gelatin-based sponges, the Office Action relies on a Gelfoam® product description dated July 2007, which is 29 years after the date of the Kelly reference, where the described product is from Pfizer, a different company than the supplier identified by Kelly. Applicants respectfully submit that the trademark term Gelfoam® as used by Pfizer in July of 2007 does not prove that the Gelfoam® swab of Messrs. McDonald & Company from 1978 contains a gelatin-based swab. Rather, the material of the Gelfoam® swab of the Kelly reference is clearly identified by Kelly as a polyester foam. Not only is the Office Action improperly relying on a trademark as indicative of the characteristics of the product, but the Office Action is also improperly using extrinsic evidence to contradict the plain teaching of the reference itself.

Moreover, this reasoning is inconsistent with the law and with USPTO policy. As explained in MPEP 2173.05(u), "[i]t is important to recognize that a trademark or trade name is used to identify a source of goods, and not the goods themselves" and "[t]hus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name." As explained by the Board in Ex Parte Kattwinkle, 12 USPQ 11 (Bd. App. 1931), "[t]he formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark." The USPTO adopts the reasoning of Kattwinkle as its policy in that the MPEP also states

> [t]he relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark.

See MPEP 608.01(v). In the present instance, the Gelfoam® swab identified by Kelly which was available in 1978 from Messrs. McDonald & Company is clearly identified by Kelly as a polyester foam swab rather than a gelatin-based sponge available under the name Gelfoam® from Pfizer in 2007. In view of the fact that the two Gelfoam® products were sold by separate companies almost 30 years apart, there is simply no basis to conclude that the 2007 Gelfoam® product of Pfizer is the same as the 1978 Gelfoam® product of Messrs. McDonald & Company, particularly where such a conclusion directly contradicts the teachings of the Kelly reference.

Where Kelly fails to teach a swab which is a gelatin-based sponge, the secondary

references D'Alessio (US Patent No. 6,283,933), Lea (US Patent Publication No. 2002/0019062), Laskey (US Patent No. 6,303,323), and Ranjane (JP 09-296004, English Abstract only) each fail to remedy the deficiency of Kelly. There is simply no teaching in any of the secondary references of a swab which is a gelatin-based sponge. Applicants respectfully request withdrawal of the rejections.

Having distinguished the independent claim from the art of record, Applicants submit that the dependent claims are patentable for at least the same reasons. However, Applicants reserve the right to separately address the patentability of those claims in the future, should that become necessary.

CONCLUSION

Applicants respectfully submit that the instant application is in condition for allowance. Entry of the amendments and an action passing this case to issue is therefore respectfully requested. In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 50-3732, Order No. 13323.105003. Furthermore, in the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-noted Deposit Account No. 50-3732 and Order No. 13323.105003.

Respectfully submitted,

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